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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/579,211

05/12/2006

Toshihiko Shirasagi

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04/07/2009

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EXAMINER

VERDERAME, ANNA L

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

04/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/579,211	Applicant(s) SHIRASAGI ET AL.
Examiner ANNA L. VERDERAME	Art Unit 1795

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 1, 4-7 and 10.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Martin J Angebrannt/
Primary Examiner, Art Unit 1795

Continuation of 11, does NOT place the application in condition for allowance because: On page 5 of the response the applicant argues that the final office action was premature. In response to the non-final office action of December 3, 2008 the applicant amended claim 1 to include the limitation of cancelled claim 3 and amended claim 7 to include the limitation of cancelled claim 9. The applicant argues that the rejection of claims 1 and 7 in paragraph 2 of the final office action is a new ground of rejection. This is incorrect. Claims 1-10 were previously rejected in paragraph 3 of the non-final action using the same set of references. Because claims 3-4 and 8-9 were cancelled these claims were removed from the list of rejected claims in the final office action. The rejection found in paragraph 2 of the non-final action was withdrawn because it did not address the limitations of claims 3 and 9 which were now included in independent claims 1 and 7.

With regard to the use of Kouchiyama et al. '391 is available under 35 U.S.C. 102(a) as it was published before the filing date of the instant application. The applicant further argues that the instant application is entitled to a benefit of the filing date for the Japanese patent application No. 2003-401836. This is correct, however the applicant must file a certified translation of the priority document to confirm that the subject matter of the instant application was disclosed in the priority document. Please perfect priority.

With regard to official notice, the examiner sees no place in the office action where the phrase "official notice" was used. The examiner assumes the applicant is referring to the examiner's assertion that Yamada et al. does in fact teach incomplete oxides of transition state metals. In this case W and Mo are transition metals. Also in this case, Yamada et al. discloses sub-oxide (this term is equivalent to incomplete oxides) WOx MoOx and TeOx. The assertion that suboxides are equivalent to incomplete oxides is based on the common way these compounds are written, e.g. TeOx WOx. This assertion is also based on the meaning of the word "sub" which can mean below or less than. For example sub-zero means less than zero. This meaning for "sub" along with the definition of an incomplete oxide given by Kouchiyama as being an oxide having less than (emphases added) the stoichiometric amount of oxygen. In conclusion the applicant's assertion that one of ordinary skill in the art would realize that sub-oxide and incomplete oxides are equivalent is supported by evidence presented in the office action.

/Martin J Angebrannt/
Primary Examiner, Art Unit 1795